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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/314,172

Applicant(s)

Hiroki Kanno.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

This communications is responsive to amendment filed on June 13, 2002.

Applicant amends claims 1-9, adds new claim 18.

### ***Response to Applicant's Remarks***

1. Applicant remarks that the amended claim 1 with "image forming means to form an image corresponding to the image data produced by the operating condition image producing means on the image formation medium" is illustrated in Fig.8B.

From Fig.8B, the operating conditions P1 are printed together with the image data P2. Thus, in claim 1, applicant claims that "image forming means to form an image corresponding to the image data produced by the operating condition image producing means on the image formation medium" without the teaching that the image data and the operating condition image are formed in the same image formation medium. Clarification is needed.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2622

3. Claims 1-7, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda (US Patent No. 5,822,507) in view of Shiota et al (US Patent No. 6,185,000).

Concerning claims 1, 18, Uda discloses an image forming apparatus (Fig.1) comprising reading means (103a-b) for reading a document; image processing means (102); image forming means (104a-d) for forming an image on an image formation medium; operating condition image producing means (107) for producing an image data indicative of status information; means for controlling the image forming means (101) to form an image corresponding to the image data from the image formation condition-producing means (Figs.1-6, 14-20; Abstract; col. 2, lines 35-49; col. 3, line 35 - col. 5, line 17).

Uda does not specifically teach that the status information is the operating conditions of the devices. However, it was commonly known in the art that the status information of a machine is equivalent to the operating conditions since both of them represent the state or the condition of the machine. It would have been obvious to one skilled in the art at the time the invention was made to consider the status information in Uda equivalent to the operating conditions as claimed since Uda also teaches that the image formation condition-producing means 107 produces the status information of at least one of the reading means, the processing means and the image formation means to the controlling means 101.

Uda fails to teach that the image data produced by the operating condition image producing means is formed on the same image formation medium with the image data processed by the image processing means. Shiota et al discloses an apparatus for instructing printing of recording information (operating condition image) together with image data on a same recording medium (Fig.1; Abstract; col. 3, line 46 – col. 5, line 3). It would have been obvious to one

skilled in the art at the time the invention was made to combine the teaching of forming an image data together with recording information in Shiota to the system in Uda since both of them teaches the reading, storing and processing of the operating condition image information and image data of a document while the operating condition image information are information correspondent to the image data of the document.

Concerning claims 2-7, Uda further teaches that the image formation condition-producing means includes means for producing a character image, a pattern code (Fig.20); means for producing an image indicative conditions of the reading means or image forming means or of the image processing means; means for forming an image indicative of a resolution, a sampling rate of the reading means (Figs.3-6, 14-20; col. 1, lines 58 - col. 2, line 22; col. 6, line 41 - col. 7, line 28; col. 10, line 32 - col. 11, line 21; col. 12, lines 31 - col. 15, line 21; col. 18, lines 25-63; col. 20, lines 8-25; col. 20, lines 8-54).

4. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda in view of Shiota as applied to claim 1 above, and further in view of Kohtani et al (US Patent No. 5,475,475).

Concerning claims 8-9, Uda fails to teach the synthesizing means for synthesizing a plurality of images into one. However, it was commonly known the art to synthesize different images from different sources to a single image. Kohtani et al support that well known in the prior art by disclosing an image forming apparatus and method in which image of a plurality of originals are formed at different positions of one recording sheet (Fig.6; Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to

combine the teaching of Kohtani et al to the system in Uda since system in Uda is connected to a plurality of scanner and printer which can receive or transmit different scanned images for printing.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nishitani et al (US Patent No. 5,966,553) teaches a system with an output device for output image together with image formation condition.

6. Applicant's arguments with respect to claims 1-9, 18 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number: 09/314,1732  
Art Unit: 2622

Page 5

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



AV  
September 18, 2002

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622